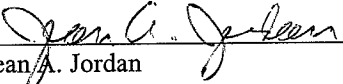


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Jean A. Jordan

2-2-07
Date

Attorney Docket No. 797.005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/757,079

Examiner: Merrick L. Dixon

Filing Date: January 14, 2004

Group Art Unit: 1774

Inventor: Michael Ian Birrell

Confirmation No.: 5345

Title: Multilayer Product Made Out Of A Substrate And On Either Side At Least One Cover Layer; Process For The Manufacture Of A Multilayer Product And Painted Multilayer Product And Process For Painting A Multilayer Product

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A Notice of Appeal is filed concurrently herewith. The Office is hereby authorized to charge deposit account 50-1170 the amount of \$1520.00 required for a three-month extension of time and the Notice of Appeal. Appellant hereby requests pre-appeal review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons set forth below.

REMARKS

Claims 1-20 are currently pending in the present application. The Examiner has unnecessary complicated the prosecution of this matter with a generally incomplete and incongruous Advisory Action mailed October 30, 2006. For clarity, as set forth below, Appellant has individually addressed each of these issues.

New Basis of Rejection Set forth in Advisory Action

In the Response filed October 2, 2006, Appellant amended claim 1 to correct an antecedent basis issue with a limitation recited therein. Specifically, Appellant inserted the term "the" in front of an

element previously recited in the claim. In the Advisory Action mailed October 30, 2006, the Examiner refused to enter this amendment as failing to place the application in better form for appeal, as raising new issues that would require further consideration and/or search, and/or raising the issue of new matter. In the continuation sheet, the Examiner further attempted to clarify the refusal to enter this amendment, an amendment that involved the insertion of the word “the” into claim 1, by asserting that “It appears applicant [sic] amendment filed 4/3/06 [sic March 29, 2006] has New Matter and it is carried over in the amendment of 10/2/06” and that “Applicant failed to state where he has support for his amendments.” Contrary to the Examiners’ last minute boot-strapping assertion, the amendments presented in the Response of March 29, 2006 have been entered and considered. The Examiner’s failure to set forth a new matter rejection in the Final Office Action of August 2, 2006 evidences that there is no supportable basis for this last minute allegation that the claims include new matter. Absent any identification of what the Examiner alleges is new matter, Appellant can only respond that that which is called for in the claims is disclosed in the application as filed. Accordingly, Appellant believes that there is no supportable basis for a new matter rejection.

Refusal to Enter the Amendments in the Response of October 2, 2006

The Examiner has also offered no supportable basis for refusing to enter the amendment filed in the Response of October 2, 2006. The amendment included the insertion of the word “the” in claim 1 to address the perceived indefinite limitation of claim 1. Such an amendment is clearly expressly authorized in 37 C.F.R. §1.116(b)(2). Clearly the Board would appreciate prior resolution of such a trivial issue however, Appellant is willing to proceed to appeal without this amendment.

Failure to Address Entirety of Response of October 2, 2006

The Examiner’s knee-jerk Advisory Action is not only nearly completely unrelated to the subject matter addressed in the Response of October 2, 2006, but the Advisory Action also wholly disregards the §1.132 Declaration filed therewith. That is, the Examiner has not indicated whether or not the §1.132 Declaration has even been entered. As evidenced by the Summary Page of the Advisory Action, it appears as though the Examiner completely disregarded the §1.132 Declaration filed with the Response of October 2, 2006. As the Declaration could not have been filed prior to the Response of October 2, 2006, as evidenced by the date of the signature thereof, Appellant requests that the Office acknowledge entry and consideration of the Declaration filed with the Response of October 2, 2006 as there is no supportable basis to refuse entry of this document.

Prior Art Rejections

Claims 1-13 and 15-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent (EPO 0259121A2), hereinafter the ‘121 publication. Claims 15 and 16 stand rejected

under 35 U.S.C. §103(a) as being unpatentable over the '121 publication in view of Mientus et al. (USP 6,770,360). Claim 14 is not mentioned in the Office Action of August 2, 2006. Furthermore, the Examiner states in the Final Office Action of August 2, 2006 that "Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection." Final Office Action, pg. 4, ¶ 6. As there is no rejection of claim 14 set forth in the Office Action, Appellant believes claim 14 has been indicated allowable and is not subject to the forthcoming appeal.

Each of the rejections set forth in the Final Office Action of August 2, 2006 relies, at least in part, upon the '121 publication. Appellant respectfully disagrees that that which is called for in the present claims is taught, suggested, or disclosed in the art of record. For brevity, and the Panels' convenience, Appellant has herein only argued the most apparent limitations of the independent claims of the above-captioned matter. Understandably, for purposes of appeal, Appellant believes that each of the claims as previously presented are patentably distinct over the art of record. Although Appellant has herein set forth only the most apparent reason for insisting on the patentability of the pending claims, the failure to discuss other limitations of the claims is in no way intended to indicate that those elements are disclosed, taught, or suggested, in the art of record. Simply for brevity, Appellant has directed to the Panels' attention to the most apparent shortcoming of the Examiner's reasoning. Although, no interpretation of the references is required, a review of the disclosures thereof clearly indicates the shortcomings of the outstanding rejections as well as the liberties the Examiner has taken with respect to the disclosure of these references.

Claim 1 calls for, in part, a multilayer product made out of a substrate and at least one cover layer at least partly covering the substrate. Claim 1 further defines that the at least one cover layer is a continuous fibre reinforced thermoplastic product that bonds at a thermoplastic material of the substrate to form a single consolidation and in which the continuous fibres are oriented approximately parallel to one another. Similarly, claim 12 defines a process of manufacturing a multilayer product that includes the steps of covering a substrate at each side at least partly with at least one cover layer. Claim 12 further defines the substrate as being a fibre reinforced thermoplastic product with randomly distributed fibres. Claim 12 further requires consolidating the fibre reinforced thermoplastic product of the substrate at the fibre reinforced thermoplastic product of the cover layer.

Independent claim 15 also defines a painted multilayer product made out of the substrate having at least one cover layer positioned at each side of the substrate. Claim 15 further defines that the at least one cover layer is a continuous fibre reinforced thermoplastic product with the fibres oriented approximately parallel to one another within each layer and wherein the fibre reinforced thermoplastic product of the substrate is consolidated to the fibre reinforced thermoplastic product of the at least one

cover layer. Claim 17 defines a process for painting a multilayer product made out of a substrate that includes bonding a fibre reinforced thermoplastic product of a consolidated substrate at the fibre reinforced thermoplastic film of at least one cover layer. As shown above, each of the independent claims of the above-captioned matter define a product or process of manufacture that includes consolidated bonding of fibre reinforced layers. That is, the consolidated laminate structure of the bonding between the respective layers of the laminate forms a compact or pore-less lamination.

The '121 publication, although related to the bonding of fibre reinforced multi-layered materials, clearly teaches away from that which the Examiner alleges is taught or suggested therein. No interpretation of the '121 publication is required. The reference is explicit that the composite material disclosed therein includes a reinforced layer that forms a light-weight composite material. That is, rather than providing a consolidated laminate material as defined by the present claims, the '121 publication teaches a laminate bonding process tailored to provide a laminate material with a layered material forming a number of generally uniform or homogenous interstitial cavities in the bonding layer. It is this cavity structure that is disclosed as allowing a lightweight composite laminate structure. The '121 publication expressly states that "at least one layer [or the composite material is] a porous fiber layer and at least one layer being a fiber reinforced plastic...." Pg. 2 l. 62, to pg. 3, l. 1.

Appellant does not necessarily disagree that the '121 publication discloses a fiber reinforced laminate material; however, Appellant has also not merely claimed a fiber reinforced laminate material. In addition to other limitations set forth in the claims, each independent claim of the above-captioned application calls for, in part, a consolidated bonding between at least two of the fibre layers. One of ordinary skill in the art, as evidenced by the §1.132 Declaration filed with the Response of October 2, 2006, would readily appreciate that a bonding engagement that includes a number of interstitial cavities or pores, is not a consolidated bonding as disclosed in the present application and called for in the pending claims. The Examiner maintains that "the resulting article [of the '121 publication] would be 'consolidated' as a final product as required by the claims." Final Office Action, pg. 2, ¶2. Curiously, the Examiner has provided no citation to the body of the '121 publication to support this assertion. Simply, not only is such an assertion unsupported by the four corners of the '121 publication, but the '121 publication teaches away from such an interpretation. That is, the entirety of the '121 publication is directed to a lightweight laminate material. As cited above, the '121 publication discloses the formation of a number of pores in the laminate to maintain the lightweight nature of the laminate formed thereby. This porous layer disclosure is integrated throughout the entirety of the '121 publication. Pg. 2, l. 17, pg. 3, l. 30; pg. 4, l. 7; pg. 6, l. 12; pg. 13, l. 28. The Examiner has simply ignored this express disclosure of

the '121 reference in a hindsight attempt at achieving the claimed invention from a reference that clearly teaches away from a consolidated fibre reinforced laminate system as claimed.

The misapplication of the '121 reference to the pending claims is further evidenced by the §1.132 Declaration filed with the Response of October 2, 2006. Therein, Dr. Hutchinson, a person who could be deemed to be more knowledgeable than a person of ordinary skill in the art, attests to the Examiner's expansion of the disclosure of the '121 publication. Specifically, Dr. Hutchinson expressly attests to such at note six (6) of the Declaration. The Examiner has provided no indication that this Declaration has even been considered in assessing the appropriateness of the scope attributed to the '121 publication. Nonetheless, the Declaration of Dr. Hutchinson only further evidences that that which is called for in the present claims is not obvious in view of the '121 publication. That is, Dr. Hutchinson attests to the understanding that a consolidated fibre material is not disclosed, suggested, or taught by the '121 publication. The Examiner's assertion that the "resulting article would be consolidated" directly contradicts the understanding of the '121 publication by a person even more skilled than one of ordinary skill in the art. Simply, not only does the '121 publication fail to disclose, teach, or suggest, that which the Examiner alleges is disclosed therein, the '121 publication expressly teaches away from the construction the Examiner contributes thereto and as presently claimed.

Therefore, in light of at least the foregoing, Appellant respectfully believes that all claims of the present application are patentable over the art of record. As a result, Appellant respectfully requests reversal of the Examiner's rejections and timely issuance of a Notice of Allowance for claims 1-20. In the alternative, Appellant requests entry of the amendment filed October 2, 2006 and passage of this matter to the Board for further substantive prosecution.

Appellant appreciates the Panel's review and cordially invites the panel members to call the undersigned, should they consider any matters unresolved.

Dated: 2/2/2007

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Respectfully submitted,



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